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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,515	09/09/2003	Mark A. Reiley	29914-701.404	1785
66854	7590	05/04/2007		
SHAY LAW GROUP, LLP 2755 CAMPUS DRIVE SUITE 210 SAN MATEO, CA 94403			EXAMINER ISABELLA, DAVID J	
			ART UNIT 3738	PAPER NUMBER
			MAIL DATE 05/04/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/658,515

Applicant(s)

REILEY, MARK A.

Examiner

DAVID J. ISABELLA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 19-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/27/06; 12/20/05; 8/24/05; 6/20/05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Election/Restrictions***

Claims 19-22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant elected species illustrated in figure 36.

Currently claims 1-18 are pending for consideration.

Applicant's election with traverse of figure 36 in the reply filed on 12/27/2006 is acknowledged. The traversal is on the ground(s) that examiner has not met the burden for establishing the requirement for species. This is not found persuasive because applicant's disclosure identifies each embodiment listed in the requirement. Whether all the claims are generic to the elected embodiment is not a proper matter for determining the bases of the restriction. It is clear that each embodiment as shown in the drawings are independent and patentably distinct. If applicant believes that there is no patentable distinction between all the embodiments, applicant is invited to state for the record that the embodiments are not patentably distinct.

The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 112***

Claims 2-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "adapted and configured" in the claims is a relative term which renders the claim indefinite. The term "adapted and configured" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. This language of the claims, absent recitation of structural features, relies solely on a functional use (ie. to replace a certain anatomical feature). The elected invention is directed to figure 36 and description of the elected illustrated device is found on pages 22-25 of the specification. Claim 1 positively sets forth structural elements of a body and a facet joint structure. However, claim 2 and all subsequent claims fail to positively set forth structure that would function after the removal of at least some of the lamina and/or other anatomical portions of the spinal process from the vertebral body. It is not clear from the specification, what form of modifications and/or structures would be inherent in the device after removal of at least some of the lamina and/or other anatomical portions of the spinal process.

The same argument is applicable for the subject matter set forth in each of the dependent claims 2-18.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by any of Wall [4633722], Homsy, et al [4778472], Morgan [4917701] and Zang [5314486].

In each reference, the illustrated prosthesis includes a prosthesis body for fixation to an anatomical bone structure and an artificial joint structure carried by the prosthesis body. In each instance, the devices are capable of performing the function as broadly set forth in the claims. With respect to claims 18 and 19, each device is made from a medical material from the group of known materials as set forth in claim 19.

Claims 2-17 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over any of Wall [4633722], Homsy, et al [4778472], Morgan [4917701] and Zang [5314486].

The term "adapted and configured" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. This language, absent structural features, relies solely on a functional use (ie. to replace a certain anatomical feature). The metes and bounds of the claims are not clearly present in the claims as it is not clear from the specification, what form of modification or structure would be inherent in the device after removal of at least some portion of the various anatomical structures as set forth in claims 2-17. It is not clear what structural distinction exist between each dependent claims as the elected embodiment of figure 36 illustrates just one prosthesis body and facet joint structure. Therefor it is not clear as to

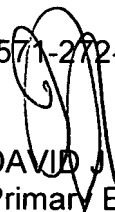
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how each claim further defines the body and joint structure of claim 1 that would be reasonably clear to one of ordinary skill in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID J. ISABELLA whose telephone number is 571-272-4749. The examiner can normally be reached on MONDAY-FRIDAY.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CORRINE MCDERMOTT can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



DAVID J. ISABELLA  
Primary Examiner  
Art Unit 3738

DJI  
3/17/2007